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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,551	02/05/2004	George Bayer	2350.421	6796
23405	7590	10/18/2006	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			BAXTER, GWENDOLYN WRENN	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,551

Applicant(s)

BAYER ET AL.

Examiner

Gwendolyn Baxter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-9 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 20 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-9 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/18/06.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

This is the third Office action for application serial number 10/773,551, Arrangements braces and methods for supporting an arm of an ornamental fixture, filed October 5, 2004. Claims 1, 3, 4, 6-9, and 11-24 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 15, 2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 3, 4, 6-9, 11, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 3-5, recite "an elongated element having ... and an upper surface that substantially conforms to the lower surface of the arm of the ornamental fixture. The ornamental fixture has been nominally recited in the preamble and not positively

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claimed by applicant. However, the top surface of the positively claimed elongated element has been defined in terms a nominally recited arm of an ornamental fixture, which is not known to be of a standard industry shape or size. In fact, the arm of the ornamental fixture can be any size or shape. Therefore, one cannot ascertain the scope of this limitation and the claim is deemed to be indefinite. Applicant must either positively claim the ornamental fixture or modify the language to be functional only, clearly stating the scope of this claim. For example, Applicant could recite "an elongated element having ... and an upper surface that is adapted to be substantially conformed to the lower surface of the arm of the ornamental fixture." Optionally, Applicant could state "A brace supporting an arm of an ornamental fixture, the arm having a lower surface...". A similar problem occurs in claim 6 and 21.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,621,927 to Reiss. The present invention reads on Reiss as follows: Reiss teaches a brace (10) comprising an elongated element (50, 24, 70) and at least one platform (60). The elongated element has a first end (52) adapted to mount

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to a support (12) and a free second end (54). The upper surface is substantially conforms to a lower surface of the arm (22) of the ornamental fixture. The platform is located between the first end and the second end. The platform is adapted to support the arm (22) of the fixture. The platform comprises a plate (60) mounted to the brace. The plate comprises a perforated plate (60, 64) adapted to mount on one or more projections (70) on the elongated element. The elongated element has at least one perforation (44). The platform comprises a surface on the elongated element.

Claims 1, 9, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,531,266 to Anderson. The present invention reads on Anderson as follows: Anderson teaches a brace comprising an elongated element (9, 10, 13) and at least one platform (21). The elongated element has a first end (near 8) adapted to mount to a support (1) and a free second end (not numbered). The upper surface is substantially conforms to a lower surface of the arm (20) of the ornamental fixture. The platform is located between the first end and the second end. The platform is adapted to support the arm (20) of the fixture. The elongated element further comprises at least one ornament mounting hook arrangement (18).

Regarding claim 18, the method is inherent since it is predicated upon the structure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiss. Reiss teaches the limitations of the base claim, excluding the upper surface of the elongated element conforms to a sinuous lower surface of the arm and the elongated element comprises a thickness between about 0.10 and 3.0 inches. Since the subcombination is being considered, it would have been an obvious matter of design choice to have made the elongated element sinuous shaped. This modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. Additionally, it would have been an obvious matter of design choice to have made the thickness of the elongated element between about 0.10 inches and about 3.0 inches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Claims 12-16, 19, 22, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson. Anderson teaches an arm (20) and brace (9, 10, 13 and 21). The arm has a first end adapted to mount to a support (1) and a second free end. The brace comprises an elongated element (9, 10, 13) and at least one platform (21). The elongated element has a first end adapted to mount to the support (1) and a free second end (near 18). The platform is mounted to the elongated element and located

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between the first end and the second end of the arm and distal the first end of the arm.

The platform is adapted to support the arm. The arm comprises a lower surface and the elongated member comprises an upper surface shaped to substantially conform to the lower surface of the arm, wherein the arm comprises a lower surface and the elongated member comprises an upper surface shaped to substantially conform to the lower surface of the arm. At least one means for mounting an ornament to the brace (18).

The arm comprises a length and wherein the platform is located at least half-length from the first end of the arm. However, Anderson fails to teach the arm being made from a brittle material such as glass and the upper surface of the elongated element conforms to a sinuous lower surface of the arm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the arm glass, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Additionally, it would have been an obvious matter of design choice to have made the elongated element sinuous shaped. This modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

Regarding claim 16, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the at least one means for mounting an ornament to the brace, namely the hook or u-shaped member in the elongated member for the purpose of supporting an article therein, since it has been

held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Regarding claim 19, the method is inherent since it is predicated upon the structure.

Allowable Subject Matter

Claims 17 and 20 are allowable.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach a cushioning material located on the platform in combination with the other elements recited therein.

Response to Arguments

Applicant's arguments filed September 15, 2006 have been fully considered but they are not persuasive.

Applicant argues that Reiss fails to show an arm. In actuality, neither does applicant show an actual arm but shows an arm only in a figurative sense of the word. Next, Applicant relies upon definition d. of *Merriam-Webster's on line dictionary* to establish or define an arm. This definition states "a slender part of a structure, machine or an instrument projecting from a main part, axis or fulcrum." By applicant's own admission an arm can be an instrument projecting from a main part. In Reiss the instrument is the book rest or arm and the main part is the designated elongated element 18. The book rest or arm, in this case, projects from the elongated element

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thus meeting applicant's definition of an arm. Then the question becomes, is it necessary for the book rest or arm of Reiss to be a slender part as applicant alleges? The answer is no. Here, Applicant is relying solely upon the first portion of *Merriam-Webster's* definition. Alternatively, there is a second part of this definition, which is worth considering. It reads as follows: "or an instrument projecting from a main part, axis or fulcrum. Therefore, the book rest or arm does not have to be a slender part as alleged by applicant.

Furthermore, Applicant states Reiss' book rest is not an arm of an ornamental fixture as shown and described in the instant application. Applicant is reminded that during patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. Reading a claim in light of the specification, to thereby interpret the limitations explicitly recited in the claim is a quite a different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. See MPEP 2111.

In response to applicant's argument that the elongated element having an upper surface fails to substantially conform to the lower surface of the arm of the ornamental fixture, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant alleges that Anderson fails to teach a platform clearly illustrated and described in the instant application. "As illustrated in Figures 4-7 of the instant application, one aspect of the invention includes a platform 75 comprising a plate 9." The Examiner agrees that Anderson does not show a platform comprising a plate. However, Applicant does not claim the platform comprising a plate in any of the independent claims, namely claims 1, 12 and 18.

Here again Applicant relies on *Merriam-Webster* on line dictionary for the definition of the word platform. This definition reads "a usually raised horizontal flat surface. Applicant alleges that Anderson "does not comprise a horizontal flat surface." A closer examination of the definition it states "a usually..." implying not always but commonly found to be so. Therefore, a platform does not have to be a horizontal flat surface.

Remarks

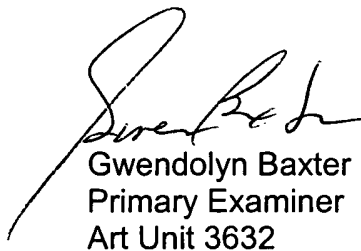
The interview summary of the interview of July 12, 2006 has been provided with this Office action to formally make of record issues of discussion. Applicant states repeated unsuccessfully attempts to contact the Examiner were made. However, fails to state that the Examiner of record returned Applicant's telephone call, but Applicant was not available. This information is merely provided to provide a fair and balanced depiction of the prosecution of this application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn Baxter whose telephone number is 571-272-6814. The examiner can normally be reached on Monday-Wednesday, 8:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gwendolyn Baxter
Primary Examiner
Art Unit 3632

September 29, 2006